

U.S. EXPRESS MAIL NO.: ED 271132022 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Web Tracking, L.L.C.,)	
)	
Petitioner,)	Cancellation No. 92043502
)	
vs.)	
)	Mark: WEBSTAT
Huntana, L.L.C., and Webstat.com, L.L.C.,)	Registration No.: 2,058,787
)	Filed: October 19, 1995
Respondents.)	Registered: May 6, 1997
)	

REPLY MEMORANDUM IN SUPPORT OF
MOTION TO SUSPEND PENDING INTER PARTES PROCEEDING

Respondent Webstat.com, L.L.C. ("Webstat"), respectfully submits the following reply memorandum in support of its Motion to Suspend Pending Inter Partes Proceeding pending disposition of Civil Case No. 2:03-CV-977 PGC previously filed by Webstat against Petitioner in the United States District Court for the District of Utah, Central Division. Webstat makes the following additional points in support of its Motion:

1. In its opposing memorandum, Petitioner does not contest that the civil action concerning the WEBSTAT mark was filed prior to the instant Petition for Cancellation.
2. Petitioner similarly does not contest that its Petition for Cancellation is based on the same arguments it raised in its motion to dismiss for failure to state a claim filed in the civil



08-31-2004

action, which motion the district court has converted to a motion for summary judgment. (*See* Mot. to Suspend Inter Partes Proceedings ¶ 8.)

3. Also, Petitioner does not contest the federal regulations and Board cases applicable to Webstat's motion, which provide that the Board may, and ordinarily will, suspend proceedings in the case before it if the final determination of a civil action will have a bearing on the issues before the Board. (*Id.* ¶ 9.)

4. Instead, Petitioner simply argues that Huntana, LLC (identified as a respondent in this proceeding) ("Huntana"), is not a party to the federal action and that Petitioner therefore may not obtain a judgment against it in that action. (Mem. Opp'n to Mot. to Suspend Proceedings at 2.) Petitioner also argues, without any authority, that the Board has a "responsibility" to render a judgment that is binding against Huntana as the original registrant of the mark. (*Id.* at 3.)

5. However, Petitioner's arguments are misplaced.

a. First, the mark at issue is currently owned by Webstat, and has been owned by Webstat since March of 2003. (*See* Trademark Assignment Abstract of Title for WEBSTAT registration, attached hereto as Exhibit 1.) Thus, there is no need for Huntana to be a party to the federal litigation, or for the Board to enter a judgment against Huntana in this proceeding. Webstat – not Huntana – is the owner of the WEBSTAT mark and is the party in interest.

b. Second, Petitioner makes much of its claim that Huntana, the assignor of the WEBSTAT mark, no longer exists. (Mem. Opp'n to Mot. to Suspend Proceedings ¶¶ 4-5; Petition for Cancellation ¶¶ 16-19.) It is therefore curious why Petitioner has added a party to this proceeding that Petitioner claims does not exist, and even more perplexing

that the absence of that purportedly non-existent party from the federal civil action should prevent a stay of this proceeding. In any event, as explained above, this issue is irrelevant because Webstat, not Huntana, is the owner of the registration at issue.

c. Third, the Board regulations provide that “[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that *a party or parties* to a pending case are engaged in a civil action or another Board proceeding which may have bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.” 37 C.F.R. § 2.117 (emphasis added). The regulation does not state “the parties” to a pending case, or “all of the parties” – just simply “a party or parties.” Thus, the regulations contemplate a stay where the other proceeding does not involve all of the parties to the proceeding before the Board. The TBMP recognizes this, providing that, “pursuant to 37 C.F.R. § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of . . . another proceeding in which only one of the parties is involved.” TBMP 510.02(a), at 500-307; *see, e.g., Argo & Co., Inc. v. Carpetsheen Mfg., Inc.*, 187 U.S.P.Q. 366, 366-67 (TTAB 1975) (granting motion to stay Board proceeding pending resolution of civil suit where opposer was not party to that suit because suit will nevertheless have a direct bearing on applicant’s registration right).

6. In addition, the very arguments Petitioner raises in its opposition memorandum concerning Huntana’s dissolution, its supposed abandonment of the WEBSTAT mark, and its supposed inability to transfer the mark, are subjects of the federal civil action. (*See* Mot. to Suspend Proceedings ¶¶ 5, 6.) Thus, the federal court will consider and dispose of these

arguments. There is no need for the Board to duplicate that effort. It will be wasteful of the Board's resources, as well as those of the parties.

7. Accordingly, Webstat respectfully submits that all further proceedings in the above-captioned cancellation proceeding be suspended pending disposition of Civil Case No. 2:03-CV-977 PGC in the United States District Court for the District of Utah, Central Division.

Please note that a Certificate of Express Mail is attached to this document. In accordance with the Rules of Practice in Trademark Cases at 37 C.F.R. section 1.10, this document should be assigned a filing date of August 31, 2004.

DATED this 31st day of August, 2004.

Respectfully submitted,

WEBSTAT.COM, L.L.C.

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CERTIFICATE OF SERVICE

I hereby certify that on this 31st day of August, 2004, a true and correct copy of the foregoing REPLY MEMORANDUM IN SUPPORT OF MOTION TO SUSPEND PENDING INTER PARTES PROCEEDING was mailed, by first-class mail, postage prepaid, to:

Lynn G. Foster
Lynn G. Foster L.C.
602 East 300 South
Salt Lake City, Utah 84102



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Date of Deposit: August 31, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above, and is addressed to Box TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

BRANDON PLEWE

(Typed or printed name of person
mailing paper or fee)

Brian Plewe

(Signature of person mailing
paper or fee)

Exhibit A



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COMPANY**Citizenship:** NONE**Entity Type:** LIMITED LIABILITY
COMPANY**Citizenship:** NONE**Assignee:** WEBSTAT.COM LLC

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Assignment: 2**Reel/Frame:** 2728/0686**Received:** 05/09/2003**Recorded:** 04/16/2003**Pages:** 2**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** HUNTANA, LLC**Exec Dt:** 02/25/2003**Entity Type:** LIMITED LIABILITY
COMPANY**Citizenship:** NONE**Entity Type:** LIMITED LIABILITY
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